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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|---------------------|------------------|
| 10/824,651 | 04/15/2004 | John E. Jesson | 1370.104.US | 7706 |
| 36139 | 7590 | 07/01/2005 | EXAMINER | |
| EPSTEIN & GERKEN 1901 RESEARCH BOULEVARD SUITE 340 ROCKVILLE, MD 20850 | | | CRANE, DANIEL C | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 3725 | |

DATE MAILED: 07/01/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|-------------------------------|------------------------------|--|
| Office Action Summary | Application No. 10/824,651 | Applicant(s) JESSON ET AL | |
| | Examiner Daniel C. Crane | Art Unit 3725 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-40 is/are pending in the application.
 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1,4,6-11,20-22,26-31 and 33-40 is/are rejected.
- 7) ☒ Claim(s) 2,3,5,12,15-19,23-25 and 32 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date <u>8/4/04</u> . | 6) <input type="checkbox"/> Other: ____. |

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BASIS FOR REJECTIONS

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

REJECTION OF CLAIMS OVER PRIOR ART

Claims 1, 11, 13, 30 and 31 are rejected under 35 U.S.C. 102(b) as being anticipated by Hill (3,292,408). See Figures 1 and 3 where the mandrel/plug 12 is provided with grooves having a pair of flank surfaces 18 and 20 that extend outwardly from a root surface 19 at different angles. A recitation of the intended use (“...for being rotatably disposed in a die orifice”) of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. See *In re Casey*, 370 F.2d 576, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 312 F.2d 937, 939, 136 USPQ 458, 459 (CCPA 1963). As to claim 30, note that the land 21 and root 19 are shown to be substantially equal.

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Claims 9 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hill (3,292,408). Whether the mandrel/plug 12 is hollow or solid is considered a matter of choice dependent upon cost considerations. Clearly, the mandrel/plug 12 is fully functional whether it is manufactured as a hollow or solid construction. The dimensional amounts are dependent upon the particular size and use of the finned tube.

Claims 1, 4, 6- 11, 20-22, 26-29, 33 and 34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kawamata (Japanese document no. 61-140319). See Figure 3 where the groove is clearly shown to have two of the flank surfaces of different angles. See also Figure 4 where the plug 4 is provided with a leading end 5 and a connector and shaft 3 to facilitate the positioning of the plug within the tubing during the helical forming operation.

Claim 35-40 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kawamata (Japanese document no. 61-140319). The operation of heat-treating and cutting tubing to length is a widely practiced in the drawing art. Such a provision, although not shown by Kawamata, would have been obvious in the manufacturing environment so as to strengthen the tubing and cut the tubing to predetermined lengths as well known in the art. Further, with reference to claims 36-40, these operations are obvious finishing operations after tube drawing so as to finally form the tube for handling, shipping and storing stock and would have been obvious in tube manufacturing facilities.

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INDICATION OF ALLOWABLE SUBJECT MATTER

Claims 2, 3, 5, 12, 15-19, 23-25 and 32 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

PRIOR ART CITED BY EXAMINER

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

RESPONSE BY APPLICANT(S)

Applicant(s) response to be fully responsive and to provide for a clear record must specifically point out how the language of the claims patentably distinguishes them from the references, both those references applied in the objections and rejections and those references cited in view of the state of the art in accordance with 37 CFR 1.111 (a), (b) and (c).

INQUIRIES

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner D. Crane whose telephone number is (571) 272-4516. The examiner's office hours are 6:30AM-5:00PM, Tuesday through Friday. The examiner's supervisor, Mr. Derris Banks, can be reached at (571) 272-4419.

Documents related to the instant application may be submitted by facsimile transmission at all times to Fax number (703) 872-9306. Applicant(s) is(are) reminded to clearly mark any

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transmission as "DRAFT" if it is not to be considered as an official response. The Examiner's

Fax number is (571) 273-4416.

DCCrane
June 24, 2005

A handwritten signature in black ink, appearing to read 'D. Crane', with a stylized, flowing script.

Daniel C. Crane
Primary Patent Examiner
Group Art Unit 3725